

REMARKS

Claims 1-15 were originally presented in the subject application. Claims 1-15 were cancelled and claims 16-47 added in a Response dated August 4, 2004. Claims 16, 20, 28, 33, 34, 36, 40, 41 and 47 were amended in a Preliminary Amendment filed April 8, 2005, with a Request for Continued Examination.

Claims 21, 37 and 44 have herein been canceled without prejudice. Claims 16, 19, 28, 32, 34, 35, 41 and 42 have herein been amended to more particularly point out and distinctly claim the subject invention. No claims have herein been added. Therefore, claims 16-20, 22-36, 38-43 and 45-47 remain in this case.

The addition of new matter has been scrupulously avoided. In that regard, support for the common amendment to independent claims 16, 34 and 41 can be found in the specification at, for example, page 4, lines 11-14.

Applicants respectfully request entry of these amendments and remarks, and reconsideration and withdrawal of the various grounds of rejection.

35 U.S.C. §102 Rejection

The Office Action rejected claims 16-30 and 32-47 under 35 U.S.C. §102(b), as allegedly anticipated by Beuk et al. (U.S. Patent No. 5,446,266). Applicants respectfully, but most strenuously, traverse this rejection.

Amended claim 16 recites a method of controlling card holder verification. The method comprises checking the presence of a trusted association between at least one device and a card usable with the at least one device. The method further comprises, if the checking indicates the presence of a trusted association, performing card holder verification without involving a holder of the card. The method further comprises, if the checking indicates no trusted association, involving the holder of the card in performing card holder verification.

Beuk et al. discloses a system with two types of cards, a unique card having a system code and one or more other cards having a security code. Any security card with the correct security code can operate the apparatus, but only the unique card with the system code can change the security code for apparatus operation. If the security code on a given security card does not match the current one in the apparatus memory, the user is asked to enter the correct security code manually.

As noted above, claim 16 recites *both* checking for a trusted association between the device and the card, and *also* performing card holder verification (without or with card holder involvement, depending on whether the trusted association is present). In contrast, Beuk et al. only checks for the proper security code on the security card, after which the machine can be used. There is no additional verification in Beuk et al. beyond checking for the security code. Thus, while there is card verification in Beuk et al., there is not in addition, card holder verification as claimed.

Therefore, Applicants submit that claim 16 cannot be anticipated by, or even made obvious over, Beuk et al.

Each of independent claims 33, 34, 40, 41 and 47 contains, in some form, limitations similar to that argued above with respect to claim 16. Thus, the remarks made above with respect to claim 16 are equally applicable thereto. Therefore, each of claims 33, 34, 40, 41 and 47 also cannot be anticipated by, or even made obvious over, Beuk et al.

### 35 U.S.C. §103 Rejection

The Office Action rejected claim 31 under 35 U.S.C. §103, as allegedly obvious over Beuk et al. in view of Sloan (U.S. Patent No. 6,179,205). Applicants respectfully, but most strenuously, traverse this rejection.

Applicants submit that claim 31 is allowable for same reasons set forth above with respect to claims 16, as well as for its additional limitations. Sloan fails to remedy the shortcomings of Beuk et al. noted above with respect to claim 16.

In addition, Applicants maintain the arguments set forth in the Appeal Brief regarding Sloan, namely, that Sloan teaches away from card holder involvement in verification. Moreover, given the allegation in the Office Action that Beuk et al. teaches card holder verification, Applicants submit that such opposite teachings would not lead one skilled in the art to combine Sloan with Beuk et al., and that Sloan is improperly combined with Beuk et al.

Claim 1 recites, for example, that “if the checking indicates no trusted association, then involving the holder of the card in performing card holder verification.”

In stark contrast, Sloan teaches (emphasis added):

Some smart card companies, such as Mondex International, currently utilize a wallet which can lock and unlock a smart card. The locking and unlocking mechanism utilizes a personal identification number (PIN) to ensure authenticity of the lock or unlock request. However, **many people prefer not to use PINs**. It is a **nuisance** to have to memorize a PIN, particularly if the person already has several PINs memorized. Additionally, a particular **PIN can be forgotten or confused** with another PIN. Further, the need for a PIN requires that the "electronic wallet" device has at least a numeric key pad to enter the PIN. This is **undesirable** for some users who do not want to carry a relatively bulky wallet with them.

What is needed is a system and method for automatically ensuring authenticity for locking and unlocking an application in a smart card which does not require the user to memorize a PIN. Preferably, the system and method may be implemented using a device which does not require the use of a bulky and expensive keypad.

Thus, Applicants submit that Sloan teaches away from card holder involvement in the verification process, and thus, teaches away from the presently claimed invention. Moreover, given the Office Action allegation that Beuk et al. teaches card holder involvement, Applicants submit these opposing teachings have two consequences. First, one skilled in the art would not be motivated to combine Sloan with Beuk et al., and second, the combination of Sloan with Beuk et al. is improper.

Therefore, Applicants submit that claim 31 cannot be rendered obvious over Beuk et al. in view of Sloan.

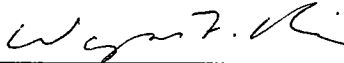
CONCLUSION

Applicants submit that the dependent claims not specifically addressed herein are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

For all the above reasons, Applicants maintain that the claims of the subject application define patentable subject matter and earnestly request entry of these remarks and allowance of claims 16-20, 22-36, 38-43 and 45-47.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,



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Dated: October 27, 2006.

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